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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/790,017 | 03/02/2004 | Naoto Yajima | 249455US0 | 3570 |
| 22850 | 7590 | 08/08/2007 | | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER BERNATZ, KEVIN M | |
| | | | ART UNIT 1773 | PAPER NUMBER |
| | | | NOTIFICATION DATE 08/08/2007 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/790,017

Applicant(s)

YAJIMA ET AL.

Examiner

Kevin M. Bernatz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6 and 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Response to Amendment

1. Preliminary amendments to the specification and claims 1 and 6, and cancellation of claim 7, filed on June 18, 2007, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Request for Continued Examination

3. A Request for Continued Examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2007 has been entered. An action on the RCE follows.

Claim Rejections - 35 USC § 103

4. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori et al. (U.S. Patent No. 5,958,565) in view of Stewart et al. (U.S. Patent No. 5,356,682) for the reasons of record as set forth in Paragraph No. 5 of the Office Action mailed on December 18, 2006; - ***and/or*** -

5. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hattori et al. (U.S. Patent No. 5,958,565) in view of Stewart et al. (U.S. Patent No. 5,356,682) and Ejiri et al. (U.S. Patent App. No. 2002/0068197 A1).

Hattori et al. and Stewart et al. are relied upon as described in Paragraph 5 of the Office Action mailed on December 18, 2006.

Regarding the amended language "wherein the magnetic tape has a curvature ... and said reference edge", the Examiner notes that this limitation was previously addressed as it pertained to prior claim 7.

Regarding the amended limitation(s) "wherein servo signals are recorded on said tracks" this is an intended use limitation and is not further limiting in so far as the structure of the product is concerned. Note that "in apparatus, article, and composition claims, intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. ***If the prior art structure is capable of performing the intended use, then it meets the claim.*** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938,

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136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. Specifically, the Examiner notes that the disclosed magnetic tape is clearly capable of having a wide variety of information stored on the tracks, from recorded data to servo tracking information. As such, since tracks possessing servo signals versus other type of recorded signals do not result in a macroscopic different in structure, the Examiner deems that the disclosed recording medium meets the claimed "intended use" limitations.

However, in the event that Applicants contend that "servo signals are recorded on said tracks" is not an intended use limitation and/or results in a structural difference, the Examiner notes that Ejiri et al. teach that it is known in the art to provide servo signals in the magnetic layer as servo tracks (i.e. to provide servo signals recorded on said servo tracks) (*Paragraphs 0001 – 0012*). The Examiner notes that such servo signals allow for good tracking of the magnetic head vis a vis the magnetic tape.

It would, therefore, have been obvious to one of ordinary skill in the art at the time of the Applicants' invention to modify the device of Hattori et al. in view of Stewart et al. to explicitly utilize servo signals recorded in said tracks as taught by Ejiri et al., since Ejiri et al. teach that it is known in the art to provide servo signals meeting Applicants' claimed limitations for achieving good tracking of the magnetic head vis a vis the magnetic tape.

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Response to Arguments

6. The rejection of claims 6 and 8 under 35 U.S.C § 103(a) – Hattori et al. in view of various references

Applicant(s) arguments have been considered but are moot in view of the new ground(s) of rejection. In so far as they apply to the present rejection of record, the Examiner notes that all of Applicants' arguments have been extensively addressed in the advisory action mailed June 8, 2007.

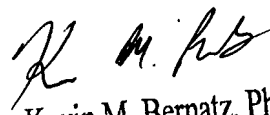
Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
August 2, 2007


Kevin M. Bernatz, PhD
Primary Examiner